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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,168	03/27/2001	Michael A. Munoz	P-5744	1917

28465	7590	07/18/2005

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EXAMINER
GOTTSCHALK, MARTIN A

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/818,168	MUNOZ ET AL.
	Examiner	Art Unit
	Martin A. Gottschalk	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _06 June 2005_.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1,7,22 and 23_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1,7,22 and 23_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _07 August 2001_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413)	
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.	
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) ☐ Notice of Informal Patent Application (PTO-152)	
Paper No(s)/Mail Date _____.	6) ☐ Other: _____.	

DETAILED ACTION

Election/Restrictions

1.   Applicant's election without traverse of claims 1-7, 22, and 23 in the reply

filed on 6/6/2005 is acknowledged.

2.   This application contains claims 8-21, 24, and 25, drawn to inventions

nonelected in the reply filed on 6/6/2005. A complete reply to the final rejection

must include cancellation of nonelected claims or other appropriate action (37

CFR 1.144) See MPEP § 821.01.

Notice to Applicant

3.   Claims 1-7, and 22 and 23 have been examined.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

5.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1,

148 USPQ 459 (1966), that are applied for establishing a background for

determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at
      issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating
      obviousness or nonobviousness.

6.   Claims 1-7, 22 and 23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Kobylevsky et al. (US Pat# 6,493,427, hereinafter Kobylevsky)

in view of Goetz et al (US Pat# 6,421,650, hereinafter Goetz).

A.   As per claim 1, Kobylevsky discloses method of processing a prescription

refill request via an interactive voice response system (Kobylevsky: abstract), the

method comprising the steps of:

      (a) providing access to an interactive response system (Kobylevsky: col 2,

lns 53-56; Fig. 1);

      (b) prompting for a pharmacy identification (Kobylevsky: Fig. 2, note the

field marked "Pharmacy Name"; and

      (c) prompting for a patient identification (Kobylevsky: col 7, lns 35-42; col

25, lns 4-5).

      Kobylevsky fails to disclose the step of

      (d) prompting for an NDC number of a medication corresponding to the

prescription to be filled.

      However, this feature is well known in the art as evidenced by the

teachings of Goetz:

Goetz teaches a health care provider inputting an NDC number

corresponding to the prescription to be filled to supply necessary information

about the medication to the patient (Goetz: col 6, lns 1-19).

It would have been obvious to one of ordinary skill in the art at the time of

the invention to incorporate the teachings of Goetz within the method of

Kobylevsky in order to provide patients easy access to complete medical

information on a prescription (Goetz: col 1, lns 64-67).

B.   As per claim 2, Kobylevsky discloses the method of claim 1, further

comprising the step of

providing an authorization for the requested refill (Kobylevsky: col 7, lns

39-42; col 29, lns 9-22;).

C.   As per claim 3, Kobylevsky discloses the method of claim 1, further

comprising the steps of:

confirming the pharmacy identification (Kobylevsky: Fig. 2, note the field

marked "Pharmacy Name"; col 25, lns 36-39; the Examiner considers the step of

entering the pharmacy's name into the computer after typing it into the provided

data entry field be a form of confirming the pharmacy identification.);

confirming the patient identification (Kobylevsky: col 7, lns 35-42. Note

the prompting for "...patient full name and phone number...". The Examiner

considers requiring these two separate pieces of information to be a form of

confirming the patient identification); and

confirming the medication (Kobylevsky: col 25, 12-23. The Examiner

considers entering the Rx number into the system followed by playback to th

customer to be a form of confirming the medication.)

D.   As per claim 4, Kobylevsky discloses the method of claim 1, further

comprising the steps of:

prompting for the date the prescription was last filled (Kobylevsky: col 7,

lns 57-61. The Examiner being required to enter the Rx number to be a form of

prompting for the date the prescription was last filled, since the Rx number will

have this date associated with it.);

prompting for the identification of the original prescribing physician

(Kobylevsky: col 7, lns 35-42, reads on "...state their full name and phone

number..."); and

prompting for the quantity of the medication (Kobylevsky: col 7, lns 40-42,

reads on "...all relevant information for the...refill authorization...". Also col 7, lns

57-61. The Examiner being required to enter the Rx number to be a form of

prompting for the quantity of the medication, since the Rx number will include the

quantity.).

E.   As per claim 5, Kobylevsky discloses the method of claim 1, wherein

        each response to a prompt is followed by a confirmation of the response

(rejected as per the reasons provided for claim 3 above); and

the prescription refill request is assigned a unique tracking identification

(Kobylevsky: col 25, 12-23. The Examiner considers the Rx number to be a

unique tracking number).

F.   As per claim 6, Kobylevsky discloses the method of claim 1, further

comprising the steps of:

creating a database entry for each prescription refill request (Kobylevsky:

col 24, lns 6-20 and 59-61).

However, Kobylevsky fails to explicitly disclose the method of claim 1,

where the database entry for each prescription refill includes:

the NDC identification and a corresponding commercial or generic name

of the medication corresponding to the NDC identification, whereby a physician

or individual may consider and provide the refill authorization based on the

commercial or generic name of the medication.

However, these features are well known in the art as evidenced by the

teachings of Goetz.

Goetz teaches a relational database which includes drug names

and their corresponding NDC numbers (Goetz: col 15, lns 32-37; Fig. 44, note in

particular the fields labeled "Drug" and "NDC"). Fig. 44, item 212 in particular

shows a step where a physician or individual might consider this information.

The motivation to combine the teachings of Goetz within the method of

Kobylevsky are the same as provided for claim 1 and is incorporated herein.

G.   As per claim 7, Kobylevsky discloses the method of claim 6, further

comprising the steps of:

providing a physician or other user access to the database entry

(Kobylevsky: col 29, lns 18-31);

prompting the physician or other user to enter comments (Kobylevsky: col

7, lns 42-45);

prompting the physician or other user to indicate approval of the request

(Kobylevsky: col 7, lns 36-42, reads on "...prompted by the system

to...<provide> refill authorization.); and

prompting the physician or other user to dispatch the indication of

approval and corresponding comments, if any, to the requesting pharmacy

(Same reasons as provided above for the rejection of the previous two

"prompting..." steps.)

Kobylevsky fails to explicitly disclose the step of:

prompting the physician or other user for the confirmation that the

requested prescription is compatible with other medications, if any, prescribed to

the patient;

However, this step is well known in the art as evidenced by the teachings

of Goetz.

Goetz teaches a system that checks a drug about to be prescribed for

potential interactions with other drugs (which would include drugs already

prescribed to the patient), then prompts for confirmation whether or not to go

ahead and prescribe the medication should potential interactions be discovered

(Goetz: col 11, 29-39; Figs 23 and 24).

The motivation to combine the teachings of Goetz within the method of

Kobylevsky are the same as provided for claim 1 and is incorporated herein.

H.   As per claims 22 and 23, they are system claims which repeat the same

limitations of claims 1 and 6, the corresponding method claims, as a collection of

elements as opposed to a series of process steps. Since the teachings

Kobylevsky and Goetz disclose the underlying process steps that constitute the

methods of claims 1 and 6, it is respectfully submitted that they provide the

underlying structural elements that perform the steps as well. As such, the

limitations of claims 22 and 23 are rejected for the same reasons given above for

claims 1 and 6.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. The cited but not applied prior art disclose automated

methods and systems for generating and fulfilling medication prescriptions (US

Pat#s 6,032,155, 5,845,255, 4,766,542, 5,935,060).

8.   Any inquiry concerning this communication or earlier communications from

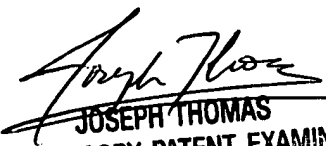the examiner should be directed to Martin A. Gottschalk whose telephone

number is (571) 272-7030. The examiner can normally be reached on Mon - Fri

8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The

fax phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

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PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

MG
7/09/2005

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